

### REMARKS

Claims 1 and 3-20 were previously pending in the above referenced patent application. No claims have been amended with this response, and these claims remain pending in this case. Of these claims, Claim 1 was amended in a previous amendment filed on 23 October 2002 into its current form. Claims 3-17 are still pending in their original form. Claims 18-20 were added in the previous amendment and remain pending. The Examiner has rejected all of the pending claims in this case. Based upon the remarks and arguments which are presented, the Applicant respectfully requests that the Examiner reconsider his rejection of the pending claims.

#### Rejection of Claims 1, 3-5, 12-14 and 18-20 for non-statutory Double Patenting

The Examiner has rejected Claims 1, 3-5, 12-14 and 18-20 under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,258,082 to the same Applicant. The Applicant acknowledges this double-patenting rejection and notes that both the current application, as well as the previously issued patent are current assigned to the same entity.

The Applicant will file an appropriate terminal disclaimer under 37 C.F.R. 1.321(c) to overcome this rejection of these claims if it is necessary. However, the Applicant respectfully requests to file this disclaimer at such time as pending Claims subject to this double-patenting rejection become otherwise allowable. The Applicant notes that the parent case over which this double patenting rejection is made, U.S. Patent No. 6,258,082, is current undergoing re-examination before the U.S.P.T.O. The parent case has also had a broadening reissue application filed based upon it. As a result, it is possible that the claims in the parent case may change prior to the issuance of the instant application.

Therefore, the Applicant believes that it is possible that the obviousness double-patenting rejection of these claims may be obviated by the proceedings in the reexamination and reissue of the parent case. In the event that such a terminal disclaimer is required, the Applicant will file such a disclaimer when the pending claims are otherwise in a condition for allowance. However, pending the outcome of the reexamination and reissue proceedings, the Applicant respectfully requests that the Examiner suspend the rejection of the pending claims and reconsider the allowability of these claims on the remaining grounds for rejection.

Provisional Rejection of Claims 1, 3-6, 11-14 and 18-20 under 35 U.S.C. §101

The Examiner has provisionally rejected Claims 1, 3-6, 11-14 and 18-20 under 35 U.S.C. §101 as claiming the same invention as that claimed in copending patent Application Serial Number 09/794,496 ("the '496 application"). The Examiner states that he believes that the claims as pending in the current application are identical in scope to certain claims pending in the '496 application. Although certain subject matter is common to the claims in both of these applications, the Applicant notes that the independent claims of these two cases are not identical and do not provide the same limitations.

For example, the Applicant notes that Claim 18 of the present case presents a set of limitations which are nowhere recited within the claims of the '496 application. Although the subject matter of Claim 18 may overlap the subject matter claimed within the '496 application, these claims are not identical in scope. Because there is a difference in the scope of the claims presented within the present application and the '496 application, the Applicant submits that the provisional statutory double patenting rejection presented by the Examiner is inapplicable to the currently pending claims. The Applicant therefore respectfully requests that to the extent that a different scope of claimed subject matter is presented in the currently pending claim set, that the provisional statutory double patenting rejection be withdrawn by the Examiner from the pending claims.

Furthermore, as the Examiner notes, a statutory type double patenting rejection can be overcome by amending the conflicting claims such that they are no longer identically extensive in scope. If claims that ultimately present identical scopes of protection are ultimately found allowable but for the double patenting rejection in either the currently pending case or the '496 application, the Applicant is prepared to amend or cancel claims as necessary to overcome the double-patenting rejection.

However, because the rejection of these claims is provisional until such time as one or the other of these cases issue, the Applicant respectfully requests that the Examiner proceed with examination of the pending claims based upon the other grounds of rejection presented by the Examiner and discussed herein by the Applicant.

Response to Rejection of Claims over U.S. Patent 5,503,165 to Schachar

The Examiner has rejected Claims 1 and 18, as well as Claims 3, 4, 11-13, 17 and 19-20 which depend from Claims 1 and 18, as being anticipated by U.S. Patent No. 5,503,165 to Schachar ("Schachar '165"). The Applicant respectfully traverses this rejection and presents the following remarks with respect to this rejection.

Initially, the Applicant would like to note that Claim 1 as currently pending contains all of the limitations presented in Claim 2 as initially filed in this application. In his Office Action of 23 April 2002, the Examiner indicated that Claim 2 was drawn to allowable subject matter and that Claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim (Claim 1) and any intervening claims. The Schachar '165 patent was cited in this Office Action against other claims pending in the case at the time.

In the Amendment submitted on 23 October 2002, the Applicant amended Claim 1 to include the limitations initially presented in Claim 2. This amended Claim 1 presented all the limitations of Claim 1 and Claim 2 as originally filed, and therefore met the stated condition for allowability by the Examiner. This amended Claim 1 is now rejected over Schachar '165.

The Examiner has rejected Claim 1 and Claim 18 as being anticipated by the Schachar '165 reference. However, Claim 1 includes certain limitations which are not disclosed in the Schachar '165 patent. Among other limitations, Claim 1 recites that "movement of the ciliary body is provided by the increase of the flexibility of said laser beam ablated scleral tissue which is filled in by sub-conjunctival tissue." With respect to the claim limitations undisclosed by Schachar '165, the Examiner suggests that such limitations would be inherent in the ablation of scleral tissue; specifically, the Examiner suggests that it is inherent that any ablated scleral tissue would be filled in by sub-conjunctival tissue. I

Nowhere within the disclosure of the Schachar '165 reference is it discussed that the ablated scleral tissue will be filled in with any particular type of tissue, nor even that any ablated scleral tissue will be filled in at all. The disclosure is entirely silent with respect to this aspect of the process. The disclosure of the Schachar '165 reference does refer to the fact that "[t]he sclera may be thinned or weakened by the surgical removal of a portion of its collagenous substance, as, for example by ablating a portion of the thickness of the sclera." (Column 7, lines 56-59, Schachar '165.) As is clearly indicated by this language, the technique described within the Schachar reference is dependent upon the sclera being "thinned or weakened", in order that inter-

ocular pressure may cause an expansion of the sclera of the eye. Such an expansion of the sclera of the eye is fundamental to the technique taught by the Schachar '165 reference.

That the ablations on the sclera would be filled in with tissue is not disclosed or suggested by the Schachar '165 reference. That the tissue which filled in any such ablations would be sub-conjunctival is not disclosed or suggested within the Schachar '165 reference. That the tissue which filled in any ablations would result in the sclera being more flexible is not disclosed or suggested in the Schachar '165 reference. In fact, the presence or absence of any of these aspects would not have any effect on the techniques disclosed within the Schachar '165 patent. That such a result does not rely on these factors can be seen by the fact that in some embodiments, the Schachar '165 patent discloses applying a band to the sclera which is *more* rigid than the sclera in order to stretch the sclera into a permanently larger configuration. ("A preferred method of increasing the diameter of the sclera in the region of the ciliary body is to fasten to the sclera in that region a relatively rigid band having a diameter slightly larger than the section of the globe of the eye in the region of the ciliary body." Column 5, lines 1-5, Schachar '165.)

Because such a filling in of tissue is not disclosed, suggested, or even useful to the techniques suggested in the Schachar '165 patent, and because the resulting increase in flexibility in the eye created by such a process is contrary to the techniques disclosed, the limitations of Claim 1 as currently pending are not disclosed or inherent to the Schachar '165 patent disclosure. Therefore, the Applicant respectfully requests that this rejection of Claim 1 and those claims which depend from Claim 1, specifically Claims 3, 4, 11-13 and 17, be withdrawn.

II { With regard to Claim 18, the Applicant respectfully notes that the Schachar '165 patent does not disclose the limitations recited within the claim. Among other limitations recited, Claim 18 includes "incising a portion of the scleral tissue of the eye through ablation to a depth of 300 - 630 microns and to a width of 0.1 - 2.0 millimeters to increase the accommodation of the eye by using an ablative laser which outputs pulses of light having a wavelength in the range of 150 - 350 nanometers or in the range of 2.6 - 3.2 microns, said pulses each having an energy of 0.1 - 30.0 milli-Joules and a pulse duration of 100 nanoseconds to 500 microseconds, said wavelength, energy and pulse duration being selected to incise the scleral tissue without causing significant thermal damage to the surrounding tissue." None of these limitations are disclosed or suggested by the Schachar '165 patent.

Because the limitations of Claim 18 are not taught or suggested by the Schachar '165 patent, the Applicant respectfully suggests that this rejection is inapplicable to Claim 18. Therefore, the Applicant requests that the Examiner reconsider his rejection of Claim 18 and those claims which depend from Claim 18, specifically, Claims 19 and 20, and withdraw this rejection from those pending claims.

Response to Rejection of Claims over U.S. Patent 5,489,299 to Schachar

The Examiner has rejected Claims 1 and 18, as well as Claims 3, 4, 11-13, 17 and 19-20 which depend from Claims 1 and 18, as being anticipated by U.S. Patent No. 5,489,299 to Schachar ("Schachar '299"). The Applicant respectfully traverses this rejection and presents the following remarks with respect to this rejection.

I (b)  
The Applicant notes that the Schachar '299 patent is the parent application to the Schachar '165 patent; the '165 patent is a divisional of the '299 patent. These two patent applications contain the same disclosure and text within their specifications, and present essentially the same prior art reference. Because of the identity of disclosure between the Schachar '165 patent and the Schachar '299 patent, the Applicant submits that the remarks presented above with respect to the Schachar '165 patent are equally applicable to any rejections made over the Schachar '299 patent.

Because the rejection is over the same disclosure as presented within the Schachar '165 patent, the Applicant respectfully requests that the §102 rejection over the Schachar '299 patent be withdrawn from pending Claims 1, 3, 4, 11-13 and 17-20.

Response to Rejection of Claims over U.S. Patent 6,258,082 to Lin

The Examiner has rejected Claims 1 and 18, as well as Claims 3-5, 12-14, and 19-20 which depend from Claims 1 and 18, as being anticipated by U.S. Patent No. 6,258,082 to Lin. The Applicant respectfully traverses this rejection and presents the following remarks with respect to this rejection.

OK 102 (b)  
The Applicant notes that the cited Lin reference is the parent case to which the pending case claims priority as a continuation-in-part under 35 U.S.C. §120. In light of this priority claim, the Applicant respectfully submits that to any extent that the Lin reference is anticipating to the pending claims, that such anticipating material also provides sufficient basis for the

claimed subject matter under 35 U.S.C. §112 in order to support a priority claim back to the filing date of the Lin reference. Therefore, the appropriate priority date for any claim directed to such anticipated material is the filing date of the Lin reference itself, because the Lin reference is the parent to the pending case.

Because the Lin reference provides its own filing date (3 May 1999) as a priority date for any claimed subject matter which is disclosed by it, the Applicant respectfully submits that the Lin reference is not prior art with respect to any claimed subject matter which is anticipated by the Lin reference. The Applicant therefore requests that the Examiner withdraw the §102(e) rejection based on the Lin reference from Claims 1, 3-5, 12-14 and 18-20.

Response to Rejection of Claims under §103

The Examiner has rejected Claims 5, 7-10 and 14-20 as being unpatentable over Schachar in view of U.S. Patent No. 6,280,435 to Odrich et al. The Examiner does not note which of the Schachar references is being applied. However, because the disclosure of both of the cited Schachar references is the same, this does not alter the analysis of the cited prior art. The Applicant respectfully traverses the rejection as applied to the currently pending claims, and submits the following remarks with respect to this rejection.

All of the rejected claims depend from either Claim 1 or Claim 18. However, as discussed above, neither of the Schachar references presented disclose, suggest or inherently include all of the recited elements of Claim 1 or Claim 18. The Examiner notes that the Odrich reference teaches the use of additional "optical scanning elements" not taught by the Schachar references. However, even the combination of the Schachar references with the Odrich reference does not disclose or suggest all of the recited elements of independent Claims 1 and 18.

With regard to those claims dependent from Claim 1, the Applicant notes that these claims are allowable if the claim from which they depend is allowable. Based on the remarks submitted above, the Applicant submits that, in addition to being allowable in their own right, Claims 5, 7-10 and 14-17 are allowable on the basis of the allowability of Claim 1 over the Schachar and Lin references. With regard to Claim 18, and Claims 19-20 which depend from Claim 18, the Applicant notes that the combination of Odrich and the Schachar references does not disclose all of the elements recited within Claim 18.

Appl. No.: 09/820,832  
Filed: March 30, 2001

Because the recited features of independent Claims 1 and 18 are not taught or suggested by the combination of the Schachar references and the Odrich reference, the Applicant submits that the §103 rejection of these claims and any claims which depend from these claims is inapplicable. The Applicant therefore respectfully requests that the Examiner withdraw the §103 rejection from Claims 5, 7-10 and 14-20.

### CONCLUSION

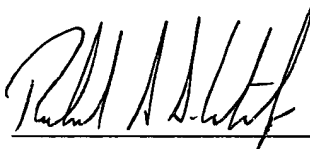
In conclusion, the Applicant submits that for the foregoing reasons, the rejections set forth in the outstanding Office Action are inapplicable to the currently pending claims. Accordingly, the Applicant respectfully requests that the Examiner reconsider his rejections of the claims and pass the application to allowance.

The undersigned has made a good faith effort to respond to all of the objections and rejections in the application and to place the claims in condition for allowance. Should the Examiner have any questions concerning the application or if any undeveloped issues remain, the Examiner is respectfully requested to call Applicant's attorney in order to promptly resolve such question or issue.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 17 July 2003

By: 

Richard A. DeCristofaro  
Registration No. 51,601  
Attorney of Record  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404